

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STANLEY C. CHESS

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Appeal No. 2001-1328  
Application 09/079,537

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ON BRIEF

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Before STAAB, MCQUADE, and NASE, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Stanley C. Chess appeals from the final rejection of claims 1 through 7, all of the claims pending in the application.

THE INVENTION

The invention relates to "multi-ply integrated label forms which expedite and simplify inventory control, shipment, tracking and return of packages" (specification, page 1). Representative claim 1 reads as follows:

1. A multi-ply integrated label form, comprising;

a first ply having an upper side and an underside and having at least one uncovered die cut window opening therein;

a second ply comprising a label portion and a card stock portion adjacent to and detachably secured to said label portion, each of said label portion and card stock portion having an upper side and an underside, part of said upper side of said label portion accessible and visible through said at least one first ply uncovered die cut window opening, said underside of said label portion being coated with an adhesive, wherein said first ply is removably secured to said second ply; and

a third ply comprising a first portion and a second portion, each of said third ply first and second portions having an upper side coated with a release material, said third ply first portion being in register with said second ply label portion and removably secured thereto by said adhesive, and said third ply second portion being in register with said second ply marginal strip portion and removably secured thereto by said adhesive.<sup>1</sup>

#### THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Neubauer	4,729,506	Mar. 8,
1988		
Doll et al. (Doll)	5,267,898	Dec. 7,
1993		

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<sup>1</sup> In the event of further prosecution, steps should be taken to correct the lack of proper antecedent basis for the terms "said second ply marginal strip portion" in claim 1 and "said uncovered die cut window openings in said first ply" in claims 4 and 5.

Appeal No. 2001-1328  
Application 09/079,537

Laurash et al. (Laurash)                      5,547,227                      Aug. 20,  
1996

#### THE REJECTIONS

Claims 1, 3 through 5 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Laurash in view of Neubauer.

Claims 2 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Laurash in view of Neubauer and Doll.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 13 and 15) and to the examiner's final rejection and answer (Paper Nos. 11 and 14) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

#### DISCUSSION

Laurash, the examiner's primary reference, pertains to multi-ply label forms adapted to facilitate various business operations. Figures 1 and 2 show an embodiment designed for use in package shipping operations, Figure 3 shows a simpler version of this embodiment, Figure 4 shows an embodiment

suites for certified mailings, and Figure 5 shows an embodiment intended for use as a medical prescription form.

In determining the differences between the subject matter claimed and the prior art, the examiner (see page 2 in the final rejection) appears to have compared the limitations in the claims to a hybrid structure composed of elements conveniently chosen from the package shipping embodiment shown in Laurash's Figures 1 and 2 and the certified mail embodiment shown in Figure 4. The examiner has not explained, however, nor is it apparent, how or why it would have been obvious to so combine these two distinct embodiments. Moreover, as conceded by the examiner (see pages 2 and 3 in the final rejection), even this highly selective combination of Laurash embodiments differs markedly from the multi-ply integrated label form recited in the claims. Simply put, Laurash's deficiencies find no cure in Neubauer's disclosure of mailers embodying covered and uncovered die cut window openings and/or in Doll's disclosure of label forms or mailers having feed strips along their edges. The examiner's conclusion to the contrary stems from an impermissible hindsight reconstruction wherein the appellant's claims have

Appeal No. 2001-1328  
Application 09/079,537

been used as a template to selectively combine isolated disclosures in the prior art without any legitimate suggestion or motivation to do so.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 7, and dependent claims 3 through 5 as being unpatentable over Laurash in view of Neubauer, or the standing 35 U.S.C. § 103(a) rejection of dependent claims 2 and 6 as being unpatentable over Laurash in view of Neubauer and Doll.

#### SUMMARY

The decision of the examiner to reject claims 1 through 7 is reversed.

#### REVERSED

Appeal No. 2001-1328  
Application 09/079,537

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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JOHN P. MCQUADE	)	
Administrative Patent Judge	)	INTERFERENCES
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JEFFREY V. NASE	)	
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